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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,048	06/29/2006	Joao Jorge Bergner	3731	6190
7590 Striker, Striker & Stenby 103 East Neck Road Huntington, NY 11743			EXAMINER OMAR, AHMED H	
			ART UNIT 2838	PAPER NUMBER
			MAIL DATE 05/08/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/585,048

**Applicant(s)**

BERGNER, JOAO JORGE

**Examiner**

AHMED OMAR

**Art Unit**

2838

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-12 and 14-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 13** is cancelled.

2. **Claims 1, 2, 6, 7, 11 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over MATHER et al. (GB 2397704 A) in view of HYODO et al. (US 6,066,938).

As per **claim 1**, MATHER discloses a device with a power tool case (See Fig.1) that includes at least one receiving area for a power tool (See Fig.1, Item#1, discloses a case and Description, Par.4 discloses the case is for the storage of the power tool) and a charger (See Fig.1 Item#3, ports, and Description Par.7 discloses the charging ports are power by battery chargers of known types), wherein the charger and the power tool case are designed to remain connected during a charging procedure (Description, Par.4 discloses the case is supplied with the charger as an integrated part of the case and not as a stand alone charger). Wherein said power tool is stored in a transport position in said first receiving area (See Description, Fig.1, and Description, Par.3, discloses a receiving area to store the power tool), but does not disclose said power tool is arranged in a second receiving area during said charging procedure in a standing

position, and wherein said second area is embodied as a stand and comprises charging contacts to transmit charging energy.

HYODO discloses a power tool charger wherein the power tool is arranged in a receiving area during said charging procedure in a standing position and embodied as a stand and comprises charging contacts to transmit charging energy (See Fig.10. Items#20 and 1, discloses a power tool charger and a power tool in a standing position during charging and Fig4, Item#46a, discloses charging contacts that come into contact with the power tool battery terminals for charging).

MATHER and HYODO are analogous art since they both deal with power tools.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by MATHER with that of HYODO such that said power tool is arranged in a second receiving area during said charging procedure in a standing position for the benefit of allowing for the easy removal of the power tool from the charger using one hand while being charged and also would allow for charging of the power tool without having to disconnect the batteries and safely storing the power tool during transportation (See HYODO Col.1, lines 20-45).

As per claim 2, MATHER in view of HYODO disclose the device as recited in Claim 1 recited above, wherein the power tool case includes installation space (See Fig.1, Item#2, charging panel) for the charger (See Fig.1 Item# 3), and the charger is designed to remain in the installation space of the power tool case during the charging procedure (Description, Par.4

discloses the case is supplied with the charger as an integrated part of the case and not as a stand alone charger).

As per **claim 6**, MATHER in view of HYODO disclose the device as recited in Claim 1 above, wherein the charger includes a wind-up device for a power cord (See MATHER, Fig.1, Item#5, retractable flex, and description, par.4 discloses the flex cord for the charger is housed inside the structure of the case with a pullout and lock and press button retraction system).

As per **claims 7**, MATHER in view of HYODO disclose a charger for a device as recited in claim 1 (See MATHER, Fig.1, Item#2, discloses charging panel).

As per **claim 11**, MATHER in view of HYODO disclose a power tool case for a device as recited in claim 1 (See MATHER Fig.1, Item#1, discloses a power tool case).

As per **claim 20**, MATHER in view of HYODO disclose the device as recited in claim 6, wherein said wind-up device comprises a rotatably supported storage means located underneath a receiving area of the charger (See MATHER Fig.1, Item#5 and 2, discloses a retractable flex cord housed underneath the receiving area of the charger).

3. Claims **1, 3, 4, 5 and 7-10, 12, 14-15 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over BURRUS, IV et al. (US 6,571,949) in view of HYODO (US 6,066,938).

As per claim 1 BURRUS discloses a device with a power tool case (See Fig.2, letm#100, case) that includes at least one receiving area (See Fig.2, Item#101, power tool receiving area) for a power tool (See Fig.1, Item#104) and a charger (See Fig.1, Items# 101,102,103; 3 charging compartments, and Par.19, discloses the compartments include charging circuitry), wherein the charger and the power tool case are designed to remain connected during a charging procedure (See. Par.19 and 20; discloses the electrical connector in the power tool case delivers electrical power to the charging circuitry within the compartment 101 in Fig.2), wherein said power tool is stored in a transport position in said first receiving area (See Fig.2, Item#101 and 104, discloses a power tool and a receiving area for receiving the power tool), but does not disclose said power tool is arranged in a second receiving area during said charging procedure in a standing position.

HYODO discloses a power tool charger wherein the power tool is arranged in a receiving area during said charging procedure in a standing position (See Fig.10. Items#20 and 1, discloses a power tool charger and a power tool in a standing position during charging).

BURRUS and HYODO are analogous art since they both deal with power tools charging.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by BURRUS with that of HYODO such that said power tool is arranged in a second receiving area during said charging procedure in a standing position for the benefit of allowing for the easy removal of the power tool from the charger using one hand while being charged while maintaining secure charging for the power tool during transportation (See HYODO Col.1, lines 20-45).

As per **claim 3**, BURRUS in view of HYODO disclose the device as recited in claim 1 above, wherein the connection (See Fig.2, Item#105, electrical connector) between the charger (See BURRUS, Fig.2, Item# 101,102,103, charging compartments) and the power tool case (See Fig.2, Item# 100) is designed to be detachable (See BURRUS, Par.23, discloses the compartments (chargers) can be fixed or removable, Par.19 discloses the compartments include charging circuitry).

As per **claim 4**, BURRUS in view of HYODO disclose the device as recited in Claim 3 as discussed above, wherein the charger (See Fig.1, Item# 101,102,103) is connected with the power tool case (See BURRUS Fig.1, Item# 100) via at least one detachable fastening means (See BURRUS, Fig.1, Item#105, connector, and Par.23, discloses that the compartments (chargers) can be fixed or removable).

As Per **claim 5**, BURRUS in view of HYODO disclose the device as recited in Claim 4 as discussed above, wherein the fastening means (See BURRUS, Fig.2, Item#105) is designed to be actuated without the use of tools (See BURRUS, Fig.2, Electrical connectors 105 snap on and off to electrical connectors within compartments 101, 102 and 103). *The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per **claim 7**, BURRUS in view of HYODO disclose a charger for a device as recited in claim 1 above (See BURRUS, Fig.1, Items# 101,102,103, and Par.19 discloses compartments include charging circuitry).

As per **claim 8**, BURRUS in view of HYODO disclose discloses the charger as recited in Claim 7 as discussed above, characterized by the fact that it is designed as a stand for the power tool (See HYODO, Fig.10, Items#1 and 20, discloses a charger used as a stand for the power tool).

As per **claim 9**, BURRUS in view of HYODO disclose the charger in claim 8 as recited above, in which the power tool (See Fig.10, Item#1) is positioned at least substantially in the machining direction (See HYODO, Fig.10, Items# 1 and 20, power tool placed on the charger in the machining position).

As per **claim 10**, BURRUS in view of HYODO disclose the charger as recited in Claim 8 above characterized by a coupling unit (See Fig.5, Item#43, positive and negative terminals on the power tool handle) that is designed to correspond with a coupling unit of a power tool unit (See Fig.2, Item#10, positive and negative electrodes on the charger) while the stand function is being performed and to at least transmit charging energy (See Col.1, lines 61-67, and Col.2, lines 1-11, disclose the electrical connection established between the first set of terminals on the power tool handle and the second set of terminals on the charger when the power tool is placed on the charger).

As per **claim 12**, BURRUS in view of HYODO disclose the device as recited in claim 1 as discussed above, wherein said power tool is stored in the transport position in said first



receiving area in a lying position (See BURRUS, et al. Fig.2, Items#101 and 104, discloses a power tool laced in a lying position while being transported).

As per claim 14, BURRUS in view of HYODO disclose the device as recited in claim 1 as discussed above, wherein said power tool projects above a half of said power tool case when said power tool is arranged in the second receiving area (See HYODO Fig.10, discloses power tool projects above a half of said power tool case when said power tool is arranged in the charging area).

As per claim 15, BURRUS in view of HYODO disclose the device as recited in claim 14 as discussed above, wherein said power tool case is reliably prevented from being closed during said charging procedure due to the standing position of said power tool ( See HYODO Fig.10, discloses the power tool projects above a half of said power tool case when said power tool is arranged in the charging area, as a result when the case will be kept open when the power tool is kept is placed in the charging position).

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over BURRUS, IV et al. (US 6,571,949) in view of HYODO (US 6,066,938) and in further view of KAJIYA (US 2003/0150756A1).

As per claim 16, BURRUS in view of HYODO disclose the device as recited in claim 3 as discussed above, wherein a connecting means for the connection between the charger and the

power tool case is integrally mounted to said power tool case (See BURRUS Fig.2, Item#105) but does not disclose the connection between the charger and the power tool case is embodied as a flexible flap.

KAJIYA discloses an electronic device case using a flexible flap as a connecting means between the case and the electronic device (See Par.4 and 5)

BURRUS, HYODO and KAJIYA are analogous art since they all deal with electronic devices.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by BURRUS in view of HYODO such that the connection between the charger and the power tool case is embodied as a flexible flap for the benefit of allowing the charger to be swung out of the case for maintenance without having to be disconnected from the case.

As per claim 19, BURRUS in view of HYODO disclose the device as recited in claim 4 as discussed above, wherein said fastening means extends through a recess in a housing wall of said power tool case (See BURRUS, Fig.3, Item#105)

5. Claim 17 and 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over BURRUS, IV et al. (US 6,571,949) in view of HYODO (US 6,066,938) and in further view of ZWEIGLE (US 6,682,361 B2)

As per claims 17 and 18, BURRUS in view of HYODO disclose the device as recited in claim 4 as discussed above, but does not disclose said fastening means is embodied as a detent element such as a latching hook.

ZWEIGLE discloses a locking mechanism comprising a detent hook (See COL.1, lines 20-23 and 63-67)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by BURRUS in view of HYODO with that of ZWEIGLE such that the fastening means is latching hook for the benefit of providing a secure releasable connection of the charger to the case (See ZWEIGLE, Col.1, lines 20-23 and 63-67, discloses a detent hook used to safeguard an electrical connection between plug parts so that it is not inadvertently released).

### **Response to Arguments**

Applicant's arguments filed on 04/20/2009 have been considered but were ineffective to overcome the rejections. (See the rejections above).

Applicant argues that the above neither MATHER nor BURRUS disclose that "... a second receiving area in which a power tool is arranged during a charging procedure in a standing position". MATHER and BURRUS, IV et al both disclose a power tool case comprising a first receiving area wherein said power tool is stored in a transport position in a lying position. HYODO teaches a power tool charger comprising a receiving area (second receiving area) wherein said power tool is arranged in said area during charging procedure in a standing position, which is embodied as a stand and comprises charging contacts. The combination of MATHER with HYODO and BURRUS with HYODO will yield a power tool

case wherein the power tool is stored in a transport position in said first receiving area, and wherein said power tool is arranged in a second receiving area during said charging procedure in a standing position. MATHER, BURRUS and HYODO are all analogous art as they all deal with power tools. The examiner has further listed the motivation to combining MATHER and HYODO and BURRUSS and HYODO as follows:

“...for the benefit of allowing for the easy removal of the power tool from the charger using one hand while being charged while maintaining secure charging for the power tool during transportation.”

Applicant argues that “HYODO would lead the practitioner to modify MATHER or BURRUS to provide one receiving area in which the tool could be charged in a standing position rather than a lying position”. The examiner respectfully disagrees since as the applicant acknowledges such a modification “could result in damage to the power tool when falling out of the charger during transport”. The examiner states that one of ordinary skill in the art would aim to combine the benefits of both references which are safe transporting and providing easy removal at the job site, the combination of both benefits would clearly be accomplished only by combining both inventions not replacing one with another.

As to applicant's argument that “... the prima facie case of obviousness is not established by the cited references, since the prior art does not suggest the desirability of the claimed invention..., and that the mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification”. The examiner respectfully disagrees and explains that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated

into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F. 2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). The examiner has further provided a motivation to combine the references states as follows:

“...for the benefit of allowing for the easy removal of the power tool from the charger using one hand while being charged while maintaining secure charging for the power tool during transportation.”

**Conclusion**

6. The prior art made of record and not relied upon is cited to establish the level of skill in the applicant's art and those arts considered reasonably pertinent to applicant's disclosure. See **MPEP 707.05(c)**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED OMAR whose telephone number is (571)270-7165. The examiner can normally be reached on Monday-Thursday 06:30-16:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Akm Ullah can be reached on 571-272-2361. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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